

Application No. 10/505,377

Reply to Office Action

*REMARKS/ARGUMENTS**The Pending Claims*

Claims 1-41 are pending. Claims 1, 2, 9, 13, 23 (in part), and 24 have been elected for prosecution pursuant to the restriction requirement. Accordingly, claims 3-8, 10-12, 14-22, and 25-41 currently are withdrawn from consideration.

Restriction Requirement and Election

The Office Action alleges that the pending claims are directed to more than one invention and requires restriction of the claims to one of twenty groups of subject matter.

Applicants elect, with traverse, the claims of group I (i.e., claims 1, 2, 9, 13, 23 (in part), and 24). Reconsideration of the requirement for restriction is respectfully requested for the reasons discussed below.

Discussion of Restriction Requirement

The subject application is a U.S. national stage application based on International Patent Application No. PCT/US03/05186. The Office Action alleges that the inventions defined by the claims of Groups I-XX do not relate to a single general inventive concept under PCT Rule 13.2 because they lack the same "special technical features." PCT Rule 13.2 is embodied in 37 C.F.R. § 1.475 ("Rule 475"). Under Rule 475, a group of inventions is considered "linked" to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. Rule 475 defines "special technical features" as "those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." 37 C.F.R. § 1.475(a). The Office Action alleges that the claims of Groups I-VII and XVII-XX represent separate and distinct products which are made by materially different methods, are used in different methods, and have different modes of operation, different functions, and different effects. In addition, the Office Action alleges that the claims of Groups I and VIII-XVI are directed to different method objectives, different method steps, parameters, and reagents.

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Applicants believe all of the claims share a common special technical feature in that all claims relate to a BORIS polypeptide or nucleic acid encoding such a polypeptide, including methods of using the same. Furthermore, certain groups of claims share common special technical features that are even more closely related. For instance, all of the claims of Groups I, II, V, and VII-XX relate to a human BORIS polypeptide, i.e., to a human BORIS polypeptide itself, a nucleic acid sequence encoding a human BORIS polypeptide, antibodies directed against a human BORIS polypeptide, methods of using a BORIS polypeptide, and a composition comprising an inhibitor of a BORIS polypeptide, all of which are sufficiently related and should be examined as part of the same application. Likewise, the claims of at least Groups III, IV, VI, and VIII-XX share a common special technical feature, which defines at least one common contribution that each claim makes over the prior art. In particular, all of the claims of Groups III, IV, VI, and VIII-XX relate to a non-human BORIS polypeptide, i.e., to a non-human BORIS polypeptide itself, a nucleic acid sequence encoding a non-human BORIS polypeptide, methods of using a BORIS polypeptide, and a composition comprising an inhibitor of a BORIS polypeptide, all of which are sufficiently related and should be examined as part of the same application.

Indeed, a search of the art for human or non-human BORIS polypeptides would be incomplete without also search for nucleic acids encoding such polypeptides, thereby warranting examination of such claims together. Also, rejoinder provisions require that a composition and method for its use should be examined together, suggesting that the method of use claims in this application should be examined alongside the composition claims.

Given the foregoing considerations, restriction is improper at least as between the claims of Groups I, II, V, and VII-XX and as between Groups III, IV, VI, and VIII-XX. Accordingly, Applicants request reconsideration of the restriction requirement.


Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

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Respectfully submitted,


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